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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,778	10/30/2003	Wen-Ching Hou	3624-0134P	6884

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/695,778	Applicant(s) HOU ET AL.	
	Examiner Sebastiano Passaniti	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/20/05.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This Office action is responsive to communication received 12/20/2004 –  
Amendment.

Claims 2 and 3 have been CANCELED, as directed.

Claims 1 and 4-13 remain pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that  
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 7, 8, 9, 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Perkins.  
As to claim 1, each of the openings (18, 40) may be considered to be recesses near the sole. These recesses each contain weight members mounted therein. Note the sealing material (22, 43), which comprises an epoxide (col. 3, lines 26-30 and col. 4, lines 8-11), which meets the limitation that a vibration-absorbable filling material being a high molecular polymer material is used to seal the opening of the recess. As to claim 5, the

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opening (40) clearly faces upward with respect to a horizontal plane containing the sole. As to claim 7, opening (23) may be considered to open downward, since the opening is at the upper toe end of the head and the recess continues downward toward the sole. As to claims 8 and 9, col. 2, line 48 in Perkins indicates that the club head may be either an iron-type or wood-type. As to claim 10, the filling material fills the opening, irregardless of the method used to introduce the epoxide within the recess. Here, the language "one of heat pressing and injection molding to bury and fix the weight member" appears to only limit the method of making the club head, not the structure. As to claim 12, the weight members in each of the three openings (18, 23, 40) are introduced within the club head via the respective openings in the head. As to claim 13, the weight members are clearly sandwiched between a bottom of the recess and the vibration-absorbable material (Figure 1).

In the alternative, while the exact material make-up of the vibration-absorbable material as claimed in claim 1 is not disclosed by Perkins, the skilled artisan, realizing that the weights must remain in the head during play and knowing that any shifting movement by the weights would adversely affect the performance of the club head, would have found it obvious to use any suitable epoxy or filler material to hold the weights in place. Any polymer material used would exhibit vibration-absorbable qualities. Insofar as the heat pressing or injection molding required by claim 10, the skilled artisan would have found it obvious to make use of any known manufacturing process through which the epoxide in Perkins would have been conveniently introduced within the openings in the head.

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Claims 1 and 4-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wargo in view of Perkins. Wargo shows every feature claimed with the exception of a vibration-absorbable filling material. Instead, Wargo shows plug (30). Perkins shows it to be old in the art to seal an opening in the head of an iron-type club head within which at least one weight is contained so that the weight is securely maintained in its position during use. Note the sealing material (22, 43) used in Perkins, which comprises an epoxide (col. 3, lines 26-30 and col. 4, lines 8-11), which meets the limitation that a vibration-absorbable filling material being a high molecular polymer material is used to seal the opening of the recess. In view of the patent to Perkins, the skilled artisan, realizing that the weights in Wargo must also remain in the head during play and knowing that any shifting movement by the weights would adversely affect the performance of the club head, would have found it obvious to replace the plug (30) with any suitable epoxy or filler material to hold the weights in place. With respect to Wargo and as to claim 1, note weight (48) received within a recession. As to claim 4, note that the external threads of the plug (30) mate with grooves in the sidewall of the recession to securely retain the plug. As to claim 5, see Figure 6. As to claim 6, see Figure 5. As to claim 7, see Figure 3. As to claim 8, note Figures 1-6. Specific to claim 11, if the Wargo device were to have been modified to only include partial grooving in the sidewall of the recession, then it would flow that only a portion of the sidewall adjacent the filling member would provide enhanced adhesion qualities. Thus, the effect of having partial grooves as opposed to grooves that completely delimit the recess would not have been unobvious to one of ordinary skill in the art. As such, the use of either

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full or partial grooving of the sidewall in light of the teaching of Wargo would have been obvious. Of further observation is the fact that in Perkins, the sidewalls of the recesses must be at least partially provided with grooves, since the weights are all adapted to be threaded within the openings. However, it is recognized that the portion of the recess adjacent the openings and containing the filler material does not explicitly show grooving of the sidewall of the recess. Nonetheless, the disclosure by Wargo and the above reasoning again obviates the use of full or partial grooving of the perimeter wall of the recesses.

#### RESPONSE TO ARGUMENTS


Applicant's arguments with respect to claims 1 and 4-13 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
March 6, 2005